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10/045,633	10/26/2001	Cheryl L. Neofytides	020375-000210US	9801

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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09/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/045,633	Applicant(s) NEOFYTIDES ET AL.	
	Examiner Harish T. Dass	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-17 and 28-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement - Examiner thanks the applicant/attorney for pointing out due to editing error in election/restriction, and made necessary corrections. Examiner acknowledges receipt of election of group I with traverse, and made necessary corrections as pointed out by applicant/attorney to overcome the applicant election with traverse to speed up the prosecution.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 and 28-31 are drawn a method for transferring credit from a sender to a plurality of recipients includes **a unique identifier for each of the plurality of recipients and a credit amount, which is defined in specification one of plurality of embodiment, where each embodiment is an invention**, classified in class 705, subclass 40.
 - II. Claims 18-27 are drawn a method for transferring credit from a sender to a plurality of recipients **wherein at least two of the plurality of credit amounts are different amounts, and the sum of a plurality of credit amounts is an aggregate credit amount**, which is another embodiment different than specified in group 1 or 3 and is classified in class 705, subclass 40.
 - III. Claims 28-31, are drawn to computer data signal embodied in a carrier wave for facilitating a credit transfer from a sender to a plurality of

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recipients where a **receiver code segment comprising a plurality of unique identifiers that correspond to the plurality of recipients** which is another embodiment different than specified in group 1 or 2 and is classified in class 705, subclass 40

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group II are related as combination and subcombination,

Inventions of group III and group II are related as combination and subcombination,

Inventions of group I and group III are related as combination and subcombination,

1. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because group I (embodiment) or II (another embodiment) or III (another embodiment) can be used without the presence of the other groups (I & II, II & III, I & III) embodiments. The subcombination has separate utility such as group I "a unique identifier for each of the plurality of recipients and a credit amount, which is defined in specification one of plurality of embodiment, where each embodiment is an invention", group II "wherein at least two of the plurality of credit amounts are different amounts, and the sum of a

plurality of credit amounts is an aggregate credit amount.", group III "a receiver code segment comprising a plurality of unique identifiers that correspond to the plurality of recipients"

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Each of the group requires separate search strategy under subclass 705/40 based on restriction requirement and for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Thomas Franklin (Reg. No. 43,616) on 03/06/2007 a provisional election was made with traverse to prosecute the invention of Group II (claims 18-27). Affirmation of this election must be made by applicant in replying to this Office action. Groups I & III (Claims 1-17 and 28-31) are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejected claims cover every conceivable product. Particularly, claim 22 includes limitation "wherein the types are chosen to include at least four from" and claim 23 includes limitation "a sub-step chosen from at least two of", where these narrow limitations are not found in original specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (hereinafter Change – US 5,884,288, 3/16/1999) in view of Landry (US 6,996,542).

Re. Claim 18, Change discloses receiving at a server computer system information from a sender to transfer credit to a plurality of recipients [see entire document particularly, col. 2 lines 38-42, lines 59-62], wherein:

the information includes a plurality of credit amounts for the plurality of recipients wherein at least two of the plurality of credit amounts are different amounts, and the sum of a plurality of credit amounts is an aggregate credit amount [Figure 8B; col. 1 lines 18-40; col. 4 lines 13-24];

determining a first handler chosen by the sender [col. 3 lines 57-67 - payor bank];
requesting credit transfer from the first handler [col. 4 lines 43-51 - instruction];
receiving at the server computer system the aggregate credit amount from the first handler [col. 1 lines 30-40];

determining a plurality of second handlers respectively chosen by the plurality of recipients [col. 1 lines 18-40 - see third party];

and sending the plurality of credit amounts to the plurality of second handlers [col. 1 lines 18-40].

Change does not explicitly disclose by interaction with server computer system to select from a plurality of different types of handlers. However, Landry discloses by interaction with server computer system [col. 38 line 46] to select from a plurality of different types of handlers [col.1 lines 43-52, col.2 lines 25-29 (see bill payment by: check, cash, money order, third party, "Bank account", etc.); col. 7 lines 11-14 (payors

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payment preferences); col. line 25-33 (payment parameters)]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Change and include by interaction with server computer system to select from a plurality of different types of handlers, as disclosed by Landry, to increase payor control over the bill payment process for multiple payee and identify financial institution and an account (handler) at that institution from which funds may be transferred to satisfy obligations.

Re. Claims 19-20, Change discloses a step of providing electronic notification from the server computer system to the plurality of recipients by email, and wherein the electronic notification includes at least one of an instant message and e-mail message [col. 2 lines 59-67].

Re. Claim 21, Change discloses wherein the first listed receiving step comprises receiving a file comprising the information [Abstract; col. 2 lines 45-48 – see electronic deposit].

Re. Claim 22, Change discloses wherein the first and second handlers include at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer [col. 4 lines 13-25 – see payor and payee banks].

Re. Claim 23, Change discloses wherein the sending step comprises at least one of the following steps: sending a credit amount to a bank account of one of the plurality of recipients; sending the credit amount to a credit card or debit card of the one; sending the credit amount as a check or money order to the one; sending the credit amount to a stored value fund of the one; sending the credit amount to an agent location chosen by the one; sending a telegram or greeting card with a check or money order to the one; and sending an electronic greeting card to the one with an electronic payment notification embedded therewith [col. 1 lines 30-48].

Re. Claim 24, Change inherently discloses triggering condition for transferring funds from recipient's account where triggering condition satisfies [see col. 4 lines 43-51 – bill payment instructions].

Re. Claim 25, Change discloses receiving a request for a credit transfer; evaluating the request against a defined parameter; and performing the credit transfer from a stored value fund of the sender so long as the request is within the defined parameter [col. 7 lines 19-33].

Re. Claim 26, Change discloses delaying the sending step until a future time specified by the sender [col. 4 lines 46-51 – “the manner”, and hold].

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Re. Claim 27, Change discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for transferring credit from the sender to the plurality of recipients using the wide-area computer network [col. 10 lines 50-56].

Response to Arguments

Applicant's arguments (6/22/07) with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
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9/1/07